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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,383	02/20/2004	David D. Zito	600189-145	6406
76041 7590 08/18/2009 YAHOO! INC. C/O Ostrow Kaufman & Frank LLP The Chrysler Building 405 Lexington Avenue, 62nd Floor NEW YORK, NY 10174				
EXAMINER				
HENRY, RODNEY M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,383

Applicant(s)

ZITO ET AL

Examiner

RODNEY HENRY

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 21, 22, 24, 26 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-20, 23, 25, 27-29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/20/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-33, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1, as best understood, it appears that the claimed method steps or processes are not statutory. Based on Supreme Court precedent ¹ and Federal Circuit decisions a §101 process must

(1) be meaningfully tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. ²

The independent claim is directed towards steps of "obtaining", and "facilitating".

Since the claims are directed to a method or a process without imposing meaningful limits on the method claim's scope (beyond data gathering and outputting, as two examples), these claims are non-statutory.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advance. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-7, 11-15, 19, 20, 23, 25, 29, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel (US 2004/0103024).**

As per Claim 1:

Patel discloses in a networked computer system, a computerized method for facilitating a transaction between at least an advertiser and an advertisee for arranging for presentation of an advertisement to at least one user of a computerized device, the method comprising:

obtaining an advertiser offer comprising conditions including a first set of one or more user context conditions required by the advertiser for presentation of the advertisement to the user;

obtaining an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user;

obtaining user context information including information relating to the first and second sets of user context conditions;

using the advertiser offer conditions, the advertisee offer conditions, and the obtained user context information, determining whether a match exists between the advertiser offer, the advertisee offer, and the user context;

and if the match exists, facilitating arranging for presentation of the advertisement to the user (see claims 49, 50, and paragraphs [0008, 0018, 0096, 0240, 0241]).

As per Claim 2:

Patel discloses obtaining a multi-dimensional advertiser offer and a multi-dimensional advertisee offer (see paragraphs [0486,0678]).

As per Claim 3:

Patel discloses facilitating arranging for presentation of the advertisement to an online Internet-based user (see FIG. 2 and paragraph [0171]).

As per Claim 4:

Patel discloses a system for facilitating a transaction between at least an advertiser and an advertisee for arranging for presentation of an advertisement to at least one user of a computerized device, the system comprising:
means for obtaining an advertiser offer comprising conditions including a first set of one or more user context conditions required by the advertiser for presentation of the advertisement to the user; means for obtaining an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user;

means for obtaining user context information including information relating to the first and second sets of user context conditions;

means for using the advertiser offer conditions, the advertisee offer conditions, and the obtained user context information, determining whether a match exists between the advertiser offer, the advertisee offer, and the user context;

and means for, if the match exists, facilitating arranging for presentation of the advertisement to the user (see claims 49, 50, and paragraphs [0008, 0018, 0096, 0240, 0241]).

As per Claim 5:

Patel discloses a system for facilitating a transaction between at least an advertiser and an advertisee for arranging for presentation of an advertisement to at least one user of a computerized device, the system comprising:

one or more offer exchange server computers connected to a network;

one or more offer exchange databases connected to the network and accessible by the

one or more offer exchange server computers, the one or more offer exchange databases storing information comprising:

an advertiser offer comprising conditions including a first set of one or more user context conditions required by the advertiser for presentation of the advertisement to the user;

an advertisee offer comprising conditions including a second set of one or more user context conditions required by the advertisee for presentation of the advertisement

to the user; user context information including information relating to the first and second sets of user context conditions;

wherein the one or more offer exchange server computers: using the advertiser offer conditions, the advertisee offer conditions, and the user context information, determine whether a match exists between the advertiser offer, the advertisee offer, and the user context; and if the match exists, facilitate arranging for presentation of the advertisement to the user (see claims 49, 50, and paragraphs [0008, 0018, 0096, 0240, 0241], and FIG. 10).

As per Claim 6:

Patel discloses the one or more offer exchange server computers obtain, and cause to be stored in the offer exchange database, the advertiser offer, the advertiser offer, and the user context information (see paragraph [0003] and FIG. 10).

As per Claim 7:

Patel discloses the system facilitates a plurality of transactions between advertisers and advertisees, and wherein the database contains a plurality of advertiser offers and a plurality of advertiser offers, and information regarding a plurality of computer user contexts (see paragraphs [0486, 0678], and FIG. 10).

As per Claim 11:

Patel discloses the one or more offer exchange servers are marketplace operator servers, and wherein the advertisee is an affiliate of the marketplace operator (see paragraph [0720], and FIG. 10).

As per Claim 12:

Patel discloses the marketplace operator obtains a fee from at least one of the advertiser and the advertisee in connection with facilitating the transaction (see paragraph [0720]).

As per Claim 13:

Patel discloses one or more advertiser computers connected to the network; one or more advertisee computers connected to the network; and one or more user computerized devices connected to the network (see FIGS. 2, 10, 13, 26).

As per Claim 14:

Patel discloses the offers each comprise one or more dimensions (see paragraphs [0008, 0011]).

As per Claim 15:

Patel discloses the one or more dimensions comprise resolutions (see Claim 11).

As per Claim 19:

Patel discloses the dimensions include at least one of user context-related dimensions, media, content, demographics, and price (paragraphs [0008, 0011]).

As per Claim 20:

Patel discloses the dimensions include at least one of price per click, price per impression, and a price per user acquisition (see paragraph [0011]).

As per Claim 23:

Patel discloses the offer exchange database comprises aggregated information useful in advertisement targeting and obtained from a plurality of affiliates; the one or more

offer exchange servers utilize the aggregated information to determine pre-defined offers considered well suited to particular categories of at least one of advertisers and advertisees;

and the one or more offer exchange servers propose pre-defined offers to at least one of advertisers and advertisees of appropriate categories for selection (see paragraph [0231]).

As per Claim 25:

Patel discloses selected proposed pre-defined offers can be at least one of modified and at least partially configured (see paragraph [0229]).

As per Claim 29:

Patel discloses the offer exchange server comprises a offer exchange engine, and wherein the offer exchange engine comprises programming comprising a plurality of virtual offer exchange machines including at least one of an offer management machine, an offer resolution control machine, and offer retrieval machine, and offer sorting machine, an offer campaign machine, and an offer distribution machine (see paragraph [0096] and Claims 10, 11).

As per Claim 31:

Patel discloses generating the pre-defined offers, and wherein at least one of matching, generating pre-defined offers, and comprising directing pre-defined offers utilizing at least one of one of a data mining program and an artificial intelligence program (see paragraphs [0231, 0096]).

As per Claim 32:

Patel discloses comprising, in matching, comparing stored offers with user context information as such user context information is obtained (see paragraphs [0018, 0096]).

As per Claim 33:

Patel discloses A computer usable medium or media storing program code which, when executed on one or more computerized devices, causes the computerized devices to execute a computerized method for facilitating a transaction between at least an advertiser and an advertisee for arranging for presentation of an advertisement to at least one user of a computerized media outlet of the advertisee, the method comprising: obtaining an advertiser offer comprising a first set of one or more user context conditions required by the advertiser for presentation of the advertisement to the user; obtaining an advertisee offer comprising a second set of one or more user context conditions required by the advertisee for presentation of the advertisement to the user; obtaining user context information including information relating to the first and second sets of user context conditions; using the obtained user context information, determining whether the user context satisfies the first and second sets of user context conditions; and if the user context satisfies the first and second sets of conditions, facilitating arranging for presentation of the advertisement to the user on a real-time or almost real-time basis (see claims 49, 50, and paragraphs [0008, 0018, 0096, 0100, 0240, 0241]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (US 2004/0103024), in view of Llach (US 2004/0186776).**

As per Claim 16:

Patel does not explicitly disclose the offers each comprise a search term-related dimension.

However, Llach discloses the offers each comprise a search term-related dimension (see paragraph [0026]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the offers each comprise a search term-related dimension to the system of Patel. One would have been motivated to do this in order to allow customers to make the relevance to offers, promotions and campaigns more effective.

As per Claim 17:

Patel does not explicitly disclose the offers each comprise a user location-related dimension.

However, Llach discloses the offers each comprise a user location-related dimension (see paragraph [0026]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the offers each comprise a user location-related dimension to the system of Patel. One would have been motivated to do this in order to gauge interest of customers by location.

As per Claim 18:

Patel does not explicitly disclose the user location related dimension is a real-time or almost real time physical location of the user.

However, Llach discloses the user location related dimension is a real-time or almost real time physical location of the user (see paragraph [0026]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the user location related dimension is a real-time or almost real time physical location of the user to the system of Patel. One would have been motivated to do this in order to gauge interest of customers by location in real-time.

8. Claims 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (US 2004/0103024), in view of Spivack et al. (US 2004/0230676).

As per Claim 27:

Patel does not explicitly disclose the marketplace operator provides virtual marketplaces in multi-dimensional offers.

However, Spivack et al. discloses the marketplace operator provides virtual marketplaces in multi-dimensional offers (see paragraph [0160]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the marketplace operator provides virtual marketplaces in multi-dimensional offers to the system of Patel. One would have been motivated to do this in order to allow for indirect interactions.

As per Claim 28:

Patel discloses using information stored in the database to determine dimensional ranges of values of dimensions of a pre-defined offer such that the pre-defined offer specifies at least one user context to which advertisements of a particular category are well-targeted (see paragraph [0231]).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Henry whose telephone number is 571-270-5102. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6102.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMH

/Arthur Duran/
Primary Examiner, Art Unit 3622